

REMARKS

Claims 1-10 are pending in the instant application. In view of Applicant's remarks below, Applicant believes the pending application is in condition for allowance. Accordingly, Applicant respectfully requests that the present Response be considered and entered, the rejections to the claims be withdrawn, and that the case now be passed to issue.

Provisional Request for Examiner Interview

Should the instant reply not result in an allowance of each of pending claims 1-10, the undersigned respectfully requests that the Examiner contact the undersigned (John Bailey, Registry # 32,881) at 703-205-8000 to schedule a personal interview at the Examiner's earliest convenience.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over either one of **Suzuki** or **JP '391** (Japanese Patent 2003-33391) in view of **Merkatoris** and **Taub**.

Reconsideration and withdrawal of each of these rejections are respectfully requested based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit

showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct 1727, 82 USPQ2d 1385 (U.S. 2007). The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (U.S. 1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

Further, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336, quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

The Present Invention and Its Advantages

The present invention relates to a method and apparatus for making a standing gather-forming member used in absorbent articles such as sanitary napkins and incontinence pads.

As recited in independent claim 1, the invention provides for:

A method of making a standing gather-forming member having a basal wall and first and second overhangs on both sides of the basal wall, comprising:

a first step of disposing at least one elastic member in the stretched state on the inner surface of a middle portion of a continuously running strip-shaped sheet along the longitudinal direction of the middle portion and Z-folding one of side portions extending on both longitudinal sides of the middle portion so as to cover a part of the width of the middle portion to form the first overhang and

a second step of folding the other side portion inward along the longitudinal direction so as to cover the part of the middle portion that remains

uncovered with the first-mentioned side portion and also overlay the Z-folded portion of the first-mentioned side portion to form the second overhang and the basal wall,
the second step following the first step (emphasis added).

As recited in pending independent claim 7, the present invention also provides for:

Apparatus for making a standing gather-forming member having a basal wall and first and second overhangs laterally extending from the basal wall,

the apparatus comprising a conveying system configured to convey along a conveying route a strip-shaped sheet having at least one elastic member disposed in the stretched state on the middle portion thereof, a first folding unit having a first guide provided on one side of the conveying route so as to narrow the width of the conveying route from that side, the first guide having an inwardly projecting projection configured to hang over a part of the middle portion on the conveying route, and a second folding unit having a second guide provided on the other side of the conveying route so as to narrow the width of the conveying route from the other side, the second guide having an inwardly projecting projection configured to hang over a part of the middle portion on the conveying route,

the projection of the first guide being configured to Z-fold one of side portions extending on both longitudinal sides of the middle portion such that the Z-folded side portion covers a part of the middle portion to form the first overhang, and

the projection of the second guide being configured to fold the other side portion inward along the longitudinal direction such that the other side portion covers the part of the middle portion that remains uncovered with the first-mentioned side portion and overlays the Z-folded portion of the first-mentioned side portion to form the second overhang and the basal wall.

Neither of the inventions set forth in pending independent claim 1 above (as well as dependent claims 2-6 that all ultimately depend from claim 1) and pending independent claim 7 above (as well as dependent claims 8-10 that all ultimately depend from claim 7) are taught or described in the cited art of record, as indicated below.

Distinctions Over the Cited Art

With respect to JP '391, Applicant has filed herewith a verified English translation of the foreign priority document, JP 2002-348980, having a filing date of November 29, 2002. The

foreign priority document supports the invention as presently claimed. Thus, Applicant has perfected a claim to priority under 35 U.S.C. § 119, and the foreign priority filing date antedates JP '391. As such, this reference does not qualify as prior art to the present invention.

Regarding Suzuki, the reference discloses a disposable diaper that has leakage preventing means containing elastic flaps that are located around the thighs and waist of the wearer. As acknowledged by the Examiner, Suzuki fails to teach the process or method of producing gathers. Specifically, the Examiner admitted, "The reference to Suzuki et al. failed to make mention of the use of folding boards which were used in sequence to form the containment flap therein...."

The Examiner relies on Merkatoris to overcome the deficiencies of Suzuki. This reference discloses the production of gathers by using a folding board. However, the gather is a one-folded gather as shown in Figs. 4-6. Merkatoris neither discloses nor suggests the production of the Z-folded portion in only one step as done in the present invention.

The Examiner also relies on Taub to overcome the deficiencies of the other cited prior art. This reference discloses the Z-folded portion as shown in Figs. 8 and 9. However, Figs. 6A-8B and Figs. 4-6 show that this portion is made through two steps.

In stark contrast, the present invention makes the first overhang of the standing gather-forming member by the first guide in the first step. In other words, the present invention, as claimed, makes the Z-folded portion as shown in Fig. 6(b) in only one step. Independent claim 1 recites, *inter alia*, a method of making a standing gather-forming member comprising:

a first step of disposing at least one elastic member in the stretched state on the inner surface of a middle portion of a continuously running strip-shaped sheet along the longitudinal direction of the middle portion and Z-folding one of side portions extending on both longitudinal sides of the middle portion so as to cover a part of the width of the middle portion to form the first overhang (emphasis added).

Similarly, independent claim 7 recites, *inter alia*, an apparatus for making a standard gathering member wherein:

the projection of the first guide being configured to Z-fold one of side portions extending on both longitudinal sides of the middle portion such that the Z-folded side portion covers a part of the middle portion to form the first overhang (emphasis added).

As explicitly recited in claims 1 and 7, the Z-folding occurs in a single step. Thus, the cited prior art of record is substantially different from the present invention since the cited prior art fails to disclose Z-folding in one step.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above, the combination of Suzuki, Merkatoris, and Taub fail to teach or suggest all the claim limitations of pending claims 1-10. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

In view of the reasons above, Applicant therefore respectfully submits that claims 1-10 clearly distinguish over the cited prior art of record.

CONCLUSION

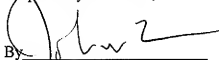
In view of the above remarks, it is believed that the claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey, Reg. No. 32,881 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated:

Respectfully submitted,



By _____
John W. Bailey
Registration No.: 32,881
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment: Verified English-language translation of Japanese priority document JP 2002-348980